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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,377

11/22/2005

Joanne Tran-Guyon

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

08/08/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@ORTPATENT.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,377	<b>Applicant(s)</b> TRAN-GUYON ET AL.	
	<b>Examiner</b> Taofiq A. Solola	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 23-50, 52 and 54 is/are pending in the application.
- 4a) Of the above claim(s) 23-26, 29 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 27, 28, 30-35 and 37-43 is/are allowed.
- 6) ☐ Claim(s) 44-50, 52, 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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Claims 23-50, 52, 54 are pending in this application.

Claims 1-22, 51, 53 are cancelled.

Claims 23-26, 29, 36, are withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 44-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 44-46 refer to figures in the specification. This is not allowed under the US patent practice. Claims 47-48 are duplicates as only fluorescein compounds are made in claim 35. They are confusing because the structure of fluorescein has phthalein. Therefore, claims 44-46 are indefinite. See *Ex parte Fressola*, supra.

Applicant should note that the requirement of 35 USC 112, is not what is obvious to one of ordinary skill in the art but a "full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same", *Lookwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed Cir. 1997).

### ***Response to Argument***

Applicant's arguments filed 3/17/08 have been fully considered but they are not persuasive. Applicant contends adding figures to claims 44-46 is not tenable. The Examiner is in total agreement with applicant on this contention. However, by reading the XRD analyses the data from the peaks could have been included in the claims.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44-50, 52, 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sujeeth, US 5,637,733; Singh, US 6,514,700; and Burdette et al., J. Am. Chem. Soc. (2001), Vol 123, pp. 7831-7841, individually.

Applicant claims compounds of formula I and compositions thereof. In preferred embodiments, the compounds are claimed as product-by-process and the composition with intended uses.

**Determination of the scope and content of the prior art (MPEP §2141.01)**

Sujeeth discloses fluorescein compounds of formula I and composition thereof.

Burdette et al., disclose compounds 1-4 and their compositions. See page 7836.

Singh discloses compounds in columns 23-28 and their compositions.

**Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)**

The difference between the instant invention and that of the prior arts is that applicant claims alkyl instead of H by the prior arts at positions R1-R5.

**Finding of prima facie obviousness---rational and motivation (MPEP §2142.2413)**

However, H and alkyl are art recognized equivalents. *In re Lincoln*, 53 USPQ 40 (CCPA, 1942); *In re Druey*, 319 F.2d 237, 138 USPQ 39 (CCPA, 1963); *In re Lohr*, 317 F.2d 388, 137 USPQ 548 (CCPA, 1963); *In re Hoehsema*, 399 F.2d 269, 158 USPQ 598 (CCPA, 1968); *In re Wood*, 582 F.2d 638, 199 USPQ 137 (CCPA, 1978); *In re Hoke*, 560 F.2d 436, 195 USPQ 148

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(CCPA, 1977); *Ex parte Fauque*, 121 USPQ 425 (POBA, 1954); *Ex parte Henkel*, 130 USPQ 474, (POBA, 1960).

When the difference between compounds is the length of a carbon chain such are adjacent homologs. However, adjacent homologs are prima facie obvious. *In re Henze*, 85 USPQ 261 (1950).

Also, patentability of product-by-process claim is based on the product itself. Though, the claims are limited and defined by their process of making, the products are unpatentable if they are the same or obvious from the product of a prior art. *In re Thorpe*, 227 USPQ 964 (CAFC, 1985). See also *Ex parte Gray*, 10 USPQ 2d 1922. Intended use in claims 51-54 is not a limitation. See *In re Hack*, 114USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949).

Therefore, the instant invention is prima facie obvious from the teachings of the prior arts. One of ordinary skill in the art would have known to replace H with alkyl and claim adjacent homologs at the time the instant invention was made. The motivation is from the knowing that H and alkyl are equivalents, and that adjacent homologs would have similar biological and/or chemical properties.

#### ***Response to Argument and Affidavit***

Applicant's arguments filed 3/17/08 have been fully considered but they are not persuasive. Applicant contends the instant crystals have higher levels of purity and unique crystal structures giving rise to different thermal behavior and different diffraction diagrams. This is not persuasive because, one of ordinary skill in the art would have known to modify the processes of the prior arts to obtain crystals having different XRD patterns at the time the instant invention was made. The motivation is from knowing that the technique and apparatus

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use for crystallization would affect the crystal structure. *Ex parte Conn and Norman*, 119 USPQ 388 (Bd Pat Appls Interf, 1955), *In re Grose and Flanigan*, 201 USPQ 57 (CCPA, 1979).

Applicant should note that XRD pattern alone is not enough to differentiate between different crystals of the same compound under the US patent practice. There must be a showing of unexpected result through side-by-side study. There must be a showing that the XRD patterns of the prior arts' crystals and all crystals of the instant compounds in public domain are different from the instant XRD patterns, and mechanical advantages arising from the different crystal structures. *Ex parte Conn and Norman*, Id and *In re Grose and Flanigan*, 201 USPQ 57 (CCPA, 1979) Id.

While the affidavit supports the existence of crystals of different structures it is not a true side-by-side study.

#### ***Allowable Claims***

Claims 27-28, 30-35, 37-43 are allowable over prior arts of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, Art Unit 1625

August 3, 2008